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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/092,374 06/05/98 SWEETZER

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QM12/0802  
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EXAMINER

MAYNARD, J

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

08/02/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/092,374

Applicant(s)

Sweezer et al.

Examiner

Jennifer Maynard

Group Art Unit

3763



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 55-58 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 55-58 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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CHUNKY DRAWING  
PATENT OFFICE

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Priority*

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must be copending with the prior application or with an application similarly entitled to the benefit of the filing date of the prior application.\*

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).\*\*

The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).\*\*\*

\*Applicant references Application No. 08/250721 filed May 27, 1994, which is now Patent No. 5,478,309, in the declaration and the specification, however the present application was not

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compending with the application to which priority is claimed. The Examiner notes however that the present application was compending with Application No. 08/566405 filed on December 1995, which is now Patent No. 5,765,568 which also claims priority to Application No. 08/250721.

**\*\*Therefore Applicant must submit a new Declaration identifying the compending Application, as well as make the necessary amendment to the first line of the specification as noted below.**

**\*\*\*The subject matter claimed in pending independent Claim 55 contains method steps which were not present in the parent applications, therefore claims of priority are not appropriate.**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 55-58 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the claimed structural matter of the catheter and the method recited steps of inserting the catheter in the subclavian artery and advancing the distal tip into the coronary ostia so as to occlude the ascending aorta, the specification does not reasonably provide enablement for the advancement of the catheter from the subclavian artery to position the expandable member in the ascending aorta between the coronary ostia and the brachiocephalic

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artery. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to reduce to practice the invention commensurate in scope with these claims. The Examiner does not doubt that the Applicant teaches almost every aspect of the method steps claimed however the specific location i.e. within the ascending aorta between the coronary ostia and the **brachiocephalic artery** is not adequately disclosed in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 55-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Bertolero et al. - '703.

Bertolero et al. discloses positioning a balloon located on the distal end of a catheter in the ascending aorta by insertion through the aorta near the subclavian artery, the catheter is advanced around the aortic arch thereby placing the balloon past the brachiocephalic artery but before the coronary ostia. The catheter has first and second lumens with openings associated with each and an expandable member attached to the distal to the first opening and proximal the second opening. Further it is disclosed to infuse oxygenated blood into the arterial system downstream of the

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expandable member, arresting the heart with the introduction of a cardioplegic fluid and further withdrawing blood via a venous catheter.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 55-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,765,568 in view of Bertolero et al.-'703.

U.S. Patent No. 5,765,568 discloses the method steps and apparatus as claimed in the pending Application 09/410487 with the exception of the location of the balloon upon advancement of the tip into the ascending aorta specifically between the coronary ostia and the brachiocephalic artery.

Bertolero et al. discloses positioning a balloon located on the distal end of a catheter in the ascending aorta by insertion through the aorta near the subclavian artery, the catheter is advanced

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around the aortic arch thereby placing the balloon past the brachiocephalic artery but before the coronary ostia.

*Conclusion*


Any inquiry concerning this communication should be directed to Jennifer Maynard at telephone number (703) 305-1356. Examiner Maynard can normally be reached at the above number from Mon-Fri. 7:30 A.M. to 5:00 P.M.

If attempts to reach examiner Maynard are unsuccessful, the examiner's supervisor Glenn Dawson can be reached at 703-308-4304. The fax number for this unit is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at 703-308-0858.

J Maynard

July 27, 2000

  
GLENN DAWSON  
FAX 703-305-3590

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